

Ex parte Cartmell et al.

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JAMES V. CARTMELL, WAYNE R. STURTEVANT
and MICHAEL L. WOLF

Appeal No. 95-4763
Application 08/144,003¹

ON BRIEF

MAILED

JAN 24 1997

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before McCANDLISH, Senior Administrative Patent Judge, and
STAAB and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed November 1, 1993. According to appellants, the application is a continuation-in-part of Application 07/862,456, filed April 2, 1992, now Patent No. 5,429,589, issued Jul. 4, 1995.

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This appeal is from the final rejection of claims 1 through 3, 5 through 7, 10 through 19, 22 and 23.² Claims 4, 8, 9, 20, 21 and 24 through 26, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

The subject matter on appeal relates to "a wound packing in the form of a flexible spirally-cut layer capable of absorbing wound exudate and a package for dispensing the wound packing" (specification, page 1). Claims 1 and 16, the two independent claims on appeal, are illustrative and read as follows:

1. A sterile wound packing comprising:

a flexible wound packing material capable of absorbing wound exudate, said flexible material in the form of a substantially flat, coiled, spirally-cut layer; and

a package for said flexible material, said package comprising sealed first and second sheets with said flexible material therebetween.

² The Notice of Appeal filed by the appellants (Paper No. 9) fails to identify the rejected claims appealed as required by 37 CFR § 1.191(b). It is apparent from the content of the main and reply briefs (Paper Nos. 10 and 12) and the examiner's answer (Paper No. 11), however, that the appeal involves the rejected claims noted above.

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16. A sterile wound packing comprising:

a flexible wound packing material capable of absorbing wound exudate, said flexible material in the form of a substantially flat, coiled, spirally-cut layer of gauze impregnated with a dehydrated hydrogel material; and

a package for said flexible material, said package comprising sealed first and second sheets with said flexible material therebetween.

The references relied upon by the examiner as evidence of anticipation and obviousness are:

Erdman et al. (Erdman)	4,676,784	Jun. 30, 1987
Cartmell et al. (Cartmell)	5,115,801	May 26, 1992
Stevenson	363,930	Dec. 31, 1931
(British Patent Document)		

The American Heritage Dictionary, Second College Edition, pp. 550 and 1177 (1982)

The claims on appeal stand rejected as follows:

a) claims 1 through 3, 5, 6, 10 and 15 under 35 U.S.C.

§ 102(b) as being anticipated by Stevenson or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Stevenson;³

³ The inclusion of claim 8, which stands withdrawn from consideration pursuant to 37 CFR § 1.142(b), in the statement of these rejections in the answer appears to be the result of an
(continued...)

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b) claim 7 under 35 U.S.C. § 103 as being unpatentable over Stevenson;

c) claims 11, 16 through 19, 22 and 23 under 35 U.S.C. § 103 as being unpatentable over Stevenson in view of Cartmell; and

d) claims 12 through 14 under 35 U.S.C. § 103 as being unpatentable over Stevenson in view of Erdman.⁴

Stevenson discloses "a container particularly adapted for supplying small pieces of material such as cotton wool or absorbent cotton in a convenient form for use without exposing the balance of the contents to contamination" (page 1, lines 13 through 18). As described by Stevenson,

³(...continued)
inadvertent oversight on the part of the examiner.

⁴ The explanation of the examiner's position in the answer indicates that the American Heritage Dictionary reference is relied upon to support each of the above rejections. This reference has not been included, however, in the statement of any of these rejections. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

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the container 3 is cylindrical and contains a coil or bundle 4 of absorbent cotton or like material in strip form.

The container is closed by a metal bottom 5 and the top or discharge end is fitted with a cap 6 comprising an inner disc or partition 7 and a top 8. The inner disc has a hole 9 which is of comparatively large diameter and serves to guide the strip 4 to a smaller hole 10 in the top 8, the material as required being pulled through the hole 10. The periphery of the hole 10 is formed with a number of slits or nicks 11 to give a certain amount of flexibility or spring as hereinbefore referred to. When not in use the top may be covered by an imperforate push-on lid 12 [page 1, lines 78 through 97].

Independent claims 1 and 16 recite a sterile wound packing comprising, inter alia, a flexible wound packing material "in the form of a substantially flat, coiled, spirally-cut layer." According to the examiner, Stevenson's disclosure of the absorbent cotton strip 4 either meets or would have suggested this feature (see pages 4, 5 and 7 through 9 in the answer).

As shown in Figure 2 of Stevenson's drawings, however, the strip 4 is coiled into an upright cylindrical form and has an upper end which extends through the hole 10 in the top 8 of the container 3. By no stretch of the imagination can this configuration be said to constitute a "substantially flat,

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coiled, spirally-cut layer" as recited in claims 1 and 16, even when this limitation is given its broadest reasonable interpretation consistent with the underlying specification. Moreover, there is nothing in the Stevenson disclosure which would have suggested modifying the absorbent cotton strip 4 to take the form of a "substantially flat, coiled, spirally-cut layer." Inasmuch as Cartmell, Erdman and/or the American Heritage Dictionary reference do not cure this deficiency in Stevenson with respect to the subject matter recited in independent claims 1 and 16, we shall not sustain any of the standing prior art rejections of these claims or of claims 2, 3, 5 through 7, 10 through 15, 17 through 19, 22 and 23 which depend therefrom.

The following new rejection is entered pursuant to 37 CFR § 1.196(b).

Claim 14 is rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention.

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Claim 14 depends from independent claim 1 via dependent claims 10 and 11 and recites that the flexible wound packing material (claim 1) is impregnated with a hydrogel (claim 11) which is "dehydrated and substantially devoid of water" (claim 14).⁵ When words of degree such as "substantially" are used in a claim, it must be determined whether the underlying specification provides some standard for measuring that degree. In other words, it must be determined whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification. See Seattle Box Co. v. Indus. Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). In the present case, the appellants' specification does not provide any reasonable standard for measuring the scope of the above noted language in claim 14. More particularly, the specification fails to give any guidance as to the amount of water that the dehydrated hydrogel may contain and still be considered to be "substantially devoid of

⁵ Claim 26, which stands withdrawn from consideration pursuant to 37 CFR § 1.142(b), contains a similar limitation.

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water." Thus, claim 14 fails to set out and circumscribe a particular area with a reasonable degree of precision and particularity.⁶

In summary:

- a) the decision of the examiner is reversed; and
- b) a new rejection of appealed claim 14 is entered pursuant to 37 CFR § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision. 37 CFR § 1.197. Should appellants elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

⁶ This rejection is essentially similar to the 35 U.S.C. § 112, second paragraph, rejection which was entered pursuant to 37 CFR § 1.196(b) in the appeal (Appeal No. 94-1384) involving parent application 07/862,456.

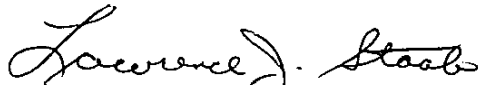
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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED; 37 CFR § 1.196(b).



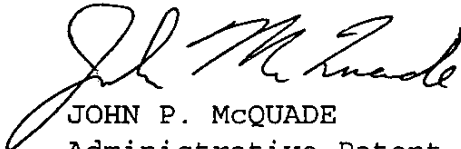
HARRISON E. McCANDLISH, Senior)
Administrative Patent Judge)



LAWRENCE J. STAAB)
Administrative Patent Judge)

BOARD OF PATENT

APPEALS AND



JOHN P. McQUADE)
Administrative Patent Judge)

INTERFERENCES

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KILLWORTH, GOTTMAN, HAGAN & SCHAEFF
One Dayton Centre
One South Main Street
Suite 500
Dayton, OH 45402-2023